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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,398	10/03/2003	Ralph Whitman	WHT.00001	3531

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EXAMINER	
SHOSHO, CALLIE E	
ART UNIT	PAPER NUMBER
1714	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/678,398	WHITMAN, RALPH	
	Examiner	Art Unit	
	Callie E. Shosho	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 February 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/6/07 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 2, 4, 6-12, 16-18, and 22-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(a) Claim 2, which depends on claim 1, recites that the "base oil includes at least one member selected from the group consisting of mineral oil, hydraulic oil, ..." while claim 1 has been amended to recite that the composition comprises "at least one member, different from said base oil and said at least one food grade hydraulic oil, selected from the group consisting of

spearmint oil, peppermint oil, fatty acids, fatty oils, hydraulic oil and combinations thereof". In light of the amendment to claim 1, it is the examiner's position that claim 2 now fails to satisfy the written description requirement under the cited statute since there does not appear to be a written description requirement in the application as originally filed of composition comprising base oil that is hydraulic oil and at least one member that is hydraulic oil that is different from the base oil, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163. Applicant has not pointed to any portion of the specification, and examiner has not found any support for this phraseology in the specification as originally filed.

It is noted that when the base oil of claim 2 is a hydraulic oil and the at least one member is hydraulic oil, the claim encompasses composition comprising base oil that is hydraulic oil and at least one member that is hydraulic oil that is different from the base oil and food grade hydraulic oil for which there is no support in the specification as originally filed. That is, there is no support in the specification as originally filed to recite that the composition comprises three different hydraulic oils, i.e. base oil hydraulic oil, food grade hydraulic oil, and another different hydraulic oil.

(b) Claim 6 recites that the spearmint oil is present in the composition at a concentrate "wherein said spearmint oil does not produce a discernable odor". An identical recitation is made with respect to the peppermint oil in the claim. The cited phraseology clearly signifies a "negative" or "exclusionary" limitation for which the applicants have no support in the original disclosure. Negative limitations in a claim which do not appear in the specification as filed introduce new concepts and violate the description requirement of 35 USC 112, first paragraph,

Ex Parte Grasselli, Suresh, and Miller, 231 USPQ 393, 394 (Bd. Pat. App. and Inter. 1983); 783 F. 2d 453.

The insertion of the above phraseology as described above positively excludes spearmint oil or peppermint oil that produces an odor, however, there is no support in the present specification for such exclusions.

As support for the above cited phrases, applicant point to paragraph 17 of the present specification.

However, while this portion of the present specification discloses that the spearmint oil and the peppermint oil emit an odor that may be undesirable and that a fragrance is used to mask the odor of the spearmint oil and the peppermint oil, this does not provide support to recite that the spearmint oil and the peppermint oil are used in amounts such that they do not produce an odor. There is no disclosure in the specification as originally filed to recite that the spearmint oil and peppermint oil are each used at a concentrate so that they each do not produce odor. While paragraph 17 provides support to recite using spearmint oil and peppermint oil such that they produce an odor that is masked by a fragrance, there is no disclosure regarding using each of spearmint oil and peppermint oil art a concentrate such that there is no odor. There is no disclosure in the present specification regarding the relationship between the amount of concentrate of spearmint oil or peppermint oil utilized and the production of odor.

(c) Claim 16 recites that the composition comprises "from about 80% to about 99.995% by volume of mineral oil" and "less than 0.005% by volume of botanical oil". It is the examiner's position that the claim fails to satisfy the written description requirement under the

cited statute since there does not appear to be a written description requirement of the above cited amounts of mineral oil and botanical oil in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163. Applicant has not pointed to any portion of the specification, and examiner has not found any support for this phraseology in the specification as originally filed.

Specifically, there is no support in the specification as originally filed to recite that the upper limit of the amount of mineral oil is about "99.995% by volume". While paragraph 8 of the present specification discloses the use of 98% by volume mineral oil and original claim 16 recited the use of about 99.5% by volume mineral oil, there is no support in the specification as originally filed to recite that that the upper limit of the amount of mineral oil is about "99.995% by volume". Further, while paragraphs 9-11 of the present specification provide support to recite that peppermint oil and spearmint oil are each present in amount of 0.015% by volume or are present in a combined amount of 0.03% by volume or 15% by volume, there is no support in the specification a originally filed to recite that botanical oil is present in amount of "less than 0.005% by volume".

(d) Claim 23 recites that the composition further comprises "botanical oil including spearmint oil and peppermint oil, the combination of said spearmint oil and said peppermint oil at about 0.003% by volume". It is the examiner's position that the claim fails to satisfy the written description requirement under the cited statute since there does not appear to be a written description requirement of the above cited amount of spearmint oil and peppermint oil in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and

MPEP 2163. Applicant has not pointed to any portion of the specification, and examiner has not found any support for this phraseology in the specification as originally filed.

While paragraphs 9-11 of the present specification provide support to recite that peppermint oil and spearmint oil are each in a combined amount of 0.03% by volume, there is no support in the specification a originally filed to recite that the peppermint oil and spearmint oil are present in amount of "less than 0.003% by volume".

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 recites an improper Markush group. In line 3 after "acid", it is advised that "or" is changed to "and".

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Wolf (U.S. 5,102,567).

Wolf discloses lubricating composition comprising 98-99.8% by weight food grade white mineral oil, anti-rust component, and anti-wear component (col.1, lines 7-10, col.2, lines 40-43, col.3, lines 14-16, 25-28, and 63-65, col.6, lines 5-7, and col.7, lines 6-9 and 27-38). It is noted that the present claims require the amount of white mineral oil in vol.% while Wolf discloses the amount in amount in wt.%. However, given that the composition of Wolf mainly comprises mineral oil, i.e. 98-99%, as does the present composition, it is clear that the amount of mineral oil disclosed by Wolf would overlap that presently claimed.

It is noted that there is no disclosure in Wolf that the composition is "for use with cutting tools used for cutting hair" as presently claimed. However, the recitation in the claims that the composition is "suitable for" use with cutting tools used for cutting hair is merely an intended use. Applicants attention is drawn to MPEP 2111.02 which states that intended use statements must be evaluated to determine whether the intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the intended use recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art and further that the prior art structure is capable of performing the intended use. Given that Wolf discloses composition as presently claimed, it is clear that the composition would be capable of

performing the intended use, i.e. for use with cutting tools used for cutting hair, presently claimed as required in the above cited portion of the MPEP.

In light of the above, it is clear that Wolf anticipates the present claims.

8. Claims 16-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Neubauer (U.S. 6,039,937).

Neubauer discloses liquid composition for treating razor comprising 95-99.9 vol.% mineral oil, small amount of peppermint oil, and rust inhibitor (col.5, lines 39-52 and col.6, lines 8-10).

In light of the above, it is clear that Neubauer anticipates the present claims.

9. Claims 1-2, 4-5, and 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Barcelon et al. (U.S. 4,853,247) taken in view of the evidence given in view of Kunz (U.S. 2005/0032653) and Avery et al. (U.S. 5,538,653).

Barcelon et al. disclose composition comprising 90-99 wt.% mixtures of unpleasant oils including mixtures of mineral oil, i.e. corresponding to presently claimed base oil or at least one member, vegetable oil, and animal oil such as fish oil or whale oil, i.e. corresponding to presently claimed base oil or at least one member (claim 1) or second oil (claim 13), and 0.1-10 wt.% mixtures of masking agents including peppermint oil and spearmint oil. It is disclosed that the peppermint oil and spearmint oil are used to mask odor and thus, it is clear that these oils function as fragrances. Further, given that the composition is an "edible" oil composition, it is clear that the mineral oil utilized must intrinsically be food grade (col.1, lines 7-10, col.1, line

60-col.2, line 5, col.3, lines 1-5, 9-19, 39-45, and 57-62, col.5, lines 56-57, and col.8, lines 53-56). It is well known, as evidenced by Kunz (paragraph 9) and Avery et al. (col.8, lines 32-33), that vegetable oil is food grade hydraulic oil.

It is noted that there is no disclosure in Barcelon et al. that the composition is "for use with cutting tools used for cutting hair" as required in all the present claims. However, the recitation in the claims that the composition is "suitable for" use with cutting tools used for cutting hair is merely an intended use. Applicants attention is drawn to MPEP 2111.02 which states that intended use statements must be evaluated to determine whether the intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the intended use recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art and further that the prior art structure is capable of performing the intended use. Given that Barcelon et al. disclose composition as presently claimed, it is clear that the composition would be capable of performing the intended use, i.e. for use with cutting tools used for cutting hair, presently claimed as required in the above cited portion of the MPEP.

In light of the above, it is clear that Barcelon et al. anticipate the present claims.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 1-2, 4-5, and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barcelon et al. (U.S. 4,853,247) in view of Kunz (U.S. 2005/0032653) and Avery et al. (U.S. 5,538,653).

Barcelon et al. disclose composition comprising 90-99 wt.% mixtures of unpleasant oils including mixtures of mineral oil, i.e. corresponding to presently claimed base oil or at least one member, vegetable oil, and animal oil such as fish oil or whale oil, i.e. corresponding to presently claimed base oil or at least one member (claim 1) or second oil (claim 13), and 0.1-10 wt.% mixtures of masking agents including peppermint oil and spearmint oil. It is disclosed that the peppermint oil and spearmint oil are used to mask odor and thus, it is clear that these oils function as fragrances. Further, given that the composition is an "edible" oil composition, it is

clear that the mineral oil utilized must intrinsically be food grade (col.1, lines 7-10, col.1, line 60-col.2, line 5, col.3, lines 1-5, 9-19, 39-45, and 57-62, col.5, lines 56-57, and col.8, lines 53-56). It is well known, as found in Kunz (paragraph 9) and Avery et al. (col.8, lines 32-33), that vegetable oil is a food grade hydraulic oil.

The difference between Barcelon et al. and the present claimed invention is (a) no explicit disclosure in Barcelon et al. of presently claimed composition and (b) no disclosure in Barcelon et al. that the composition is for use with cutting tools used for cutting hair.

With respect to difference (a), it is noted that while Barcelon et al. fail to exemplify the presently claimed composition nor can the claimed composition be "clearly envisaged" from Barcelon et al. as required to meet the standard of anticipation (cf. MPEP 2131.03), nevertheless, in light of the overlap between the claimed composition and the composition disclosed by Barcelon et al. as described above, absent a showing of criticality for the presently claimed composition, it is urged that it would have been within the bounds of routine experimentation, as well as the skill level of one of ordinary skill in the art, to use composition which is both disclosed by Barcelon et al. and encompassed within the scope of the present claims an thereby arrive at the claimed invention.

With respect to difference (b), it is noted that there is no disclosure in Barcelon et al. that the composition is "for use with cutting tools used for cutting hair" as required in all the present claims. However, the recitation in the claims that the composition is "suitable for" use with cutting tools used for cutting hair is merely an intended use. Applicants attention is drawn to MPEP 2111.02 which states that intended use statements must be evaluated to determine whether the intended use results in a structural difference between the claimed invention and the prior art.

Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the intended use recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art and further that the prior art structure is capable of performing the intended use. Given that Barcelon et al. disclose composition as presently claimed, it is clear that the composition would be capable of performing the intended use, i.e. for use with cutting tools used for cutting hair, presently claimed as required in the above cited portion of the MPEP, and thus, one of ordinary skill in the art would have arrived at the claimed invention.

Allowable Subject Matter

12. Claims 19-21 are allowable over the "closest" prior art Wolf (U.S. 6,039,937), Barcelon (U.S. 4,853,247), and Neubauer (U.S. 6,039,937) given that there is no disclosure or suggestion in Wolf, Barcelon, or Neubauer of composition comprising mineral oil, spearmint oil, peppermint oil, fish oil, emu oil, fatty acid, dye, fragrance, and anti-wear/non-corrosive additive (claim 19) or composition comprising mineral oil, spearmint oil, peppermint oil, emu oil, fatty acid, fragrance, and anti-wear/non-corrosive additive (claim 21).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
4/14/07